

REMARKS

Claims 1-7, 9 and 11-23 are pending in the instant application.

Claims 8 and 10 have been previously cancelled, without prejudice.

Claims 1 and 9 have been amended herewith. Applicant submits that support for this amendment may be found in the specification as filed at least on page 1, lines 1-3. Applicant submits no new matter has been added by way of this amendment.

Claims 17-21(*sic*) have been previously withdrawn from consideration. Applicant notes the Examiner has indicated in the instant Office Action that Claims 22 and 23 have been previously withdrawn in the Office Action Summary, but then lodges the two following rejections including these two Claims. Applicant requests clarification regarding the status of Claims 22 and 23, but has provided arguments herein that are inclusive of Claims 22 and 23.

Claims 1-7 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wright (U.S. Patent No. 5,707,358).

Claims 9, 11-16 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright '358.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-7 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wright (U.S. Patent No. 5,707,358). Applicant respectfully traverses the rejection and requests withdrawal of same.

Applicant's invention provides a catheter useful for non-surgical entry into a uterus to dispense a diagnostic fluid therein which comprises a tubular body having a single lumen extending from the first end of the tubular body to the second end of the tubular body, where the lumen has an external opening adjacent to the first end of the body and a second opening in fluid communication with the balloon, which is adjacent to the first end of the tubular body, and further wherein the external opening adjacent to the first end generates a back-flow within the lumen which causes the fluid to enter and inflate the balloon through the second opening. Applicant has amended Claims 1 and 9 herewith to indicate that a single lumen is employed in Applicant's invention.

Wright (U.S. Patent No. 5,707,358) teaches a cardioplegia catheter for use in cardiac surgery which comprises an elongated flexible tube having a proximal and distal end, wherein said tube has at least a first and second lumina lengthwise there through, with a first and second expandable balloon.

Wright does not teach a catheter useful for non-surgical entry into a uterus to dispense a diagnostic fluid therein, wherein said catheter comprises a single lumen with a first opening adjacent to the first end of the catheter, a balloon, and where said lumen has a second opening in fluid communication with the balloon, which is adjacent to the first end of the tubular body, and further wherein the external opening adjacent to the first end generates a back-flow within the lumen which causes the fluid to enter and inflate the balloon through the second opening. The cardioplegia catheter of Wright teaches a catheter having multiple lumina (a first and second lumina), and a first and second balloon. Applicant's invention provides a single lumen catheter for use in non-surgical entry into a uterus. Wright does not teach a single lumen catheter for the function discussed above.

All of the elements of Applicant's invention are not provided by Wright. Wright cannot therefore anticipate Applicant's invention. Applicant respectfully requests withdrawal of the rejection.

Rejection Under 35 U.S.C. § 103(a)

Claims 9, 11-16 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright '358. Applicant respectfully traverses the rejection and requests withdrawal of same.

Applicant's invention provides a catheter apparatus useful for non-surgical entry into a uterus to dispense a diagnostic fluid therein which comprises a catheter, a syringe, and a catheter having a balloon and a single lumen extending from the first end of the catheter to the second end of the catheter, where the lumen has an external opening adjacent to the first end of the body and a second opening in fluid communication with the balloon, which is adjacent to the first end of the tubular body, and further wherein the external opening adjacent to the first end generates a back-flow within the lumen which causes the fluid to enter and inflate the balloon through the second opening.

Wright (U.S. Patent No. 5,707,358) teaches a cardioplegia catheter for use in cardiac surgery which comprises an elongated flexible tube having a proximal and distal end, wherein said tube has at least a first and second lumina lengthwise there through, with a first and second expandable balloon.

The Examiner has stated in the Office Action dated January 12, 2004 that Wright “fails to include a syringe for delivering fluid to the catheter. The Examiner further states that “syringes are well known in the art to be used as a balloon inflation mechanism. One skilled in the art would have relied on their knowledge of commonly used devices for inflating balloon in order to use an easily accessible mechanism to perform the procedure of the device.”

Applicant maintains that Wright does not teach or suggest the catheter apparatus of Applicant's invention. Wright does not teach or suggest a single lumen catheter, or a catheter having a syringe, nor does Wright teach or suggest a catheter having a single lumen wherein the external opening adjacent to the first end generates a back-flow within the lumen which causes the fluid to enter and inflate the balloon through the second opening. Further, Applicant maintains that having the knowledge of the physics of balloon inflation would not obviate the catheter apparatus of Applicant's invention, contrary to the Examiner's position. Applicant maintains a *prima facie* case of obviousness has not been established. Applicant respectfully requests withdrawal of the rejection.

CONCLUSION

Applicant respectfully requests allowance of now pending Claims 1-7, 9, 11-16, 22 and 23. Should the Examiner believe that issues remain outstanding, the Examiner is respectfully requested to call Applicant's undersigned attorney in an effort to resolve such issues.

Respectfully submitted,

LATHROP & GAGE L.C.

A handwritten signature in black ink, appearing to read "Janelle D. Strode", is written over a horizontal line.

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